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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,754	04/05/2000	Osamu Sekihata	FUSA 17.211	6383
7590 02/23/2004				
Katten, Muchin, Zavis & Rosenman 575 Madison Ave. New York, NY 10022-2585				
			EXAMINER HOM, SHICK C	
			ART UNIT 2666	PAPER NUMBER 8
DATE MAILED: 02/23/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/543,754

Applicant(s)

SEKIHATA, OSAMU

Examiner

Shick C Hom

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-18 is/are allowed.
- 6) ☒ Claim(s) 1,5,9 and 12 is/are rejected.
- 7) ☒ Claim(s) 2-4,6-8,10,11 and 13-15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments with respect to claims 1-18 have been considered but are moot in view of the new ground(s) of rejection.

### *Specification*

2. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

3. Claim 12 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-4 of U.S. Patent No. 5,734,654. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application's claim 12 merely broaden the scope of the U.S. Patent No. 5,734,654 claims 2-4 by eliminating the priority information provided for the identifier, communication processing in accordance with the determined priority level, and frame discarding corresponding to priority information as in claims 2-3. The application's claim 12 merely broaden the scope of U.S. Patent No. 5,734,645 depend claim 4 which recite discarding received frame in the transmitting buffer having the same identifier as that of the received frame. It has been held that the omission of a element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be obvious to one skilled in the art.

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4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 5 rejected under 35 U.S.C. 102(e) as being anticipated by Ganesan et al. (5,519,640).

Regarding claim 1:

Ganesan et al. disclose the frame forwarding installation for sending a received frame to a path conforming to a

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destination address contained in a header of the frame, which has been received from a transmitting terminal, comprising: an application discriminating unit for referring to the header of the received frame and determining whether an application of a host layer in the transmitting terminal is a real-time application; and a frame transmitting unit for sending the received frame to a plurality of paths in the direction of a destination if the application is a real-time application (see col. 4 line 65 to col. 5 line 6 which recite processing the frame according to the media type indicated at the application layer, col. 5 line 57 to col. 6 line 4 which recite the application header of the frame being used to indicate the media type information, e.g. application identifier as to voice data and the transmitter, col. 7 lines 17-23 which recite the incoming traffic being voice telephone conversation clearly anticipate real-time traffic, col. 14 lines 5-13 which recite determining from the header whether application is voice traffic, and col. 4 lines 17-24 which recite setting up connection to the dial destination clearly reads on the transmitting unit for sending received frame to paths in the direction of the destination if the application is real-time application).

Regarding claim 5:

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Ganesan et al. disclose the frame forwarding installation for sending a received frame to a path conforming to a destination address contained in a header of the frame, which has been received from a transmitting terminal, comprising: an application-type discriminating unit for referring to the header of the received frame and discriminating the type of application of a host layer in the transmitting terminal; and a frame transmitting unit for transmitting the received frame to a plurality of paths in the direction of a destination if the type of an application is a predetermined type (see col. 4 line 65 to col. 5 line 6 which recite processing the frame according to the media type indicated at the application layer, col. 5 line 57 to col. 6 line 4 which recite the application header of the frame being used to indicate the media type information, e.g. application identifier as to voice data and the transmitter, col. 7 lines 17-23 which recite the incoming traffic being voice telephone conversation, col. 14 lines 5-13 which recite determining from the header whether application is voice traffic, and col. 4 lines 17-24 which recite setting up connection to the dial destination clearly reads on the transmitting unit for sending received frame to paths in the direction of the destination if the application is a predetermined type).

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7. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Saito 95,751,954).

Regarding claim 9:

Saito discloses the frame forwarding installation for sending a received frame to a path conforming to a destination address contained in a header of the frame, which has been received from a transmitting terminal, comprising: an address-match discriminating unit for determining whether the destination address or transmission-source address contained in the header of the received frame matches an address that has already been registered; and a frame transmitting unit for sending the received frame to a plurality of paths in the direction of a destination if the addresses match (see col. 10 lines 4-44 which recite the destination address contained in the header of the frame and col. 6 lines 56-61 which recite the unit for determining whether the destination address is a registered address before sending the received frame to the direction of the destination).

***Allowable Subject Matter***

8. Claims 16-18 are allowed.

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9. Claims 2-4, 6-8, 10-11, and 13-15 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Valentine et al. disclose systems and methods for routing a message through a signaling network associated with a public switched telephone network (PSTN), including a method for performing global title routing on an Internet protocol (IP) address.

11. Any response to this nonfinal action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for Technology Center 2600 only)

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA., Sixth Floor (2600 Receptionist at (703) 305-4750).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shick Hom whose telephone number is (703) 305-4742. The examiner's regular work schedule is Monday to Friday from 8:00 am to 5:30 pm EST and out of office on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao, can be reached at (703) 308-5463.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

SH

February 17, 2004

  
D. M. KINGSTON  
TECHNICAL EXAMINER